REMARKS

The specification has been amended at page 1 to alert the Examiner to twenty-four co-pending related applications. Claims 1-51 remain in the application.

Claims 1-51 are provisionally rejected for obviousness-type double patenting over claims of the applicants' co-pending application Serial No. 09/728,693. In view of the fact that prosecution is still ongoing in that application, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in both applications.

Claims 1-51 are provisionally rejected for obviousness-type double patenting over claims of the applicants' co-pending application Serial No. 09/679,038. In view of the fact that prosecution is still ongoing in that application, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in both applications.

Claims 1-51 are provisionally rejected for obviousness-type double patenting over claims of the applicants' co-pending application Serial No. 09/679,039. In view of the fact that prosecution is still ongoing in that application, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in both applications.

Claims 1-4, 9, 10, 15-17, 23-25, 27-30, 33, 34, 41-48, and 50 are rejected for anticipation by US Patent No. 5,848,397 ("Marsh"). That rejection is respectfully traversed as follows.

Axiomatically, rejection of a claim for anticipation by a reference requires that the reference describe every element or step of the rejected claim, together with each limitation thereof, explicitly or inherently.

Taking claim 1 as representative, a client device configured for communications with a multiplicity of other client devices via a communications network is claimed. The client device includes "means for effecting an advertisement download communication link between the client device and an advertisement distribution server system, via the communications network, at selected advertisement download times", together with "means for effecting a data communication link with a data communications service provider, via the communications network, wherein the advertisement download communication link and the data communication link are separate communication links", and further includes "means for downloading advertisements from the advertisement distribution server system via the advertisement download communication link", and:

"means for storing downloaded advertisements on a storage medium associated with the client device; and

means for displaying at least selected ones of the stored advertisements, in accordance with ad display parameters prescribed by the advertisement distribution server system."

Marsh discloses a message scheduling apparatus that is served by a single "e-mail server system 104" consisting of multiple mail servers M_i. See FIGS. 1 and 8. A client system 101 receives all data, e-mail, messages, and advertisements from an e-mail server in the e-mail server system 104. See Marsh at column 6, lines 15-25. The e-mail server system has a component called an advertisement distribution scheduler, but this is merely an adaptation of the e-mail server system giving it an ability to handle downloading of advertisements as well as e-mail messages. Take away the e-mail server capability of Marsh's system, and nothing would be downloaded; take away the advertisement download scheduler and e-mail would still be downloaded. Further, the advertisement display scheduler 700 stationed at the client system 101 "receives all of the advertisements it will show from the server system 104", not from "an advertisement distribution server system". See Marsh at column 13, lines 55-58. Accordingly, Marsh omits "means for effecting an advertisement download communication link between the client device and an advertisement distribution server system, via the communications network, at selected advertisement download times".

Marsh also omits any description of an "advertisement download communication link" that is "separate" from any other link, because advertisements are downloaded in connections for e-mail delivery. At column 16, lines 19-32, Marsh states that upon "any given connection between the client system 101 and the server system 104, the advertisement download scheduler decides" which advertisements will also be downloaded at that time. In fact, at column 16, lines 50-59, Marsh states that the advertisement download scheduler spreads "downloading of advertisements during any one connection between the client system 101 and the server system 104." As a complete reading of this passage reveals, Marsh's advertisement download scheduler downloads advertisements with-mail messages. Marsh's message scheduling system does not include an "advertisement distribution server system" that downloads advertisements on links ("connections") that are "separate" from any other links. Marsh therefore omits "means for effecting a data communication link with a data communications service provider, via the communications network, wherein the advertisement download communication link and the data communication link are separate communication links".

Consequently, Marsh omits a client device combination comprising:

"means for effecting an advertisement download communication link between the client device and an advertisement distribution server system, via the communications network, at selected advertisement download times;" and

"means for effecting a data communication link with a data communications service provider, via the communications network, wherein the advertisement download communication link and the data communication link are separate communication links;".

If the omitted material is considered to be inherent in Marsh, the applicants respectfully request the submission of extrinsic evidence showing that the omitted material is necessarily in the advertisement scheduling apparatus described by Marsh and would be recognized as such by the person of ordinary skill. Otherwise, Marsh does not anticipate claims 1-4, 9, 10, 15-17, 23-25, 27-30, 33, 34, 41-48, and 50.

Claims 5-8, 11-14, 18-22, 26, 31, 32, 35-40, and 51 are rejected for obviousness over Marsh. That rejection is respectfully traversed for the following reasons.

Prima facie rejection of a claim for obviousness over a modified reference requires some suggestion or motivation in the prior art to modify the reference as proposed, a reasonable expectation of success, and the inclusion of all elements in the modified reference. See MPEP §2142 et seq.

Claims 5-8, 11-14, 18-22, 26, 31, 32, and 35-40 depend from claim 1 and therefore include the combination of "means for effecting an advertisement download communication link between the client device and an advertisement distribution server system" in combination with "means for effecting a data communication link with a data communications service provider" where "the advertisement download communication link and the data communication link are separate communication links"; claim 51 also includes this combination. As already pointed out, Marsh omits this combination.

In addition, as admitted in the Office Action, Marsh further omits "the maximum number of times per day that each stored advertisement is to be displayed and the date/time before which each stored advertisement is to be displayed and the end date/time after which each stored advertisement should not be displayed." Nevertheless, Official Notice is taken that it is "old and well known in advertisements/marketing to make certain determinations" such as those recited in claims 5-8, 11, 12, 26, 31, 32, and 51 "in order to better target the correct time for advertisements." The applicants respectfully submit that such is not the case. Advertising by

communication with computers is unique in advertising/marketing. The communication channel to a computer provides the ability to exchange information, including advertising, as well as the ability to conduct sales transactions and distribute goods and services. The ad audience size is the currency of advertising media. Managing ad display and life time are therefore very important functions. Advertising scheduling for computer users is an evolving discipline, involving critical issues. As Marsh points out, advertisers "run the risk of users being numbed or otherwise negatively affected by their advertising as the result of overexposure." Marsh, column 2, lines 54-56. The applicants have a further concern: scheduling of ads delivered in batches to client device software. In this regard, "it is unlikely that either the software provider or the client software will be able to derive a significant benefit from the ad scheduling algorithms currently run on ad services. This is in part due to the fact that the ads being displayed by the e-mail client software are divorced from the content being displayed, i.e., neither the software provider nor the client software are cognizant of the content of any particular ad that the user is looking at, and in part due to the fact that the e-mail client software will be requesting ads in a batch for later display, rather than requesting them in "real time"". Specification page 38, lines 17-28. Accordingly, the applicants submit that the parameters recited in claims 5-8, 11, 12, 26, 31, 32, and 51 are not of such "notorious character" that Official Notice can be taken of them. The applicants therefore respectfully request citation of a supporting reference. MPEP 2144.03, second paragraph. Otherwise, the rejection of claims 5-8, 11, 12, 26, 31, 32, and 51 should be withdrawn.

For reasons similar to those detailed above in respect of claims 5-8, 11, 12, 26, 31, 32, and 51, the applicants also request citation of a reference to support the Official Notice taken in support of the rejection of claims 13 and 14. Otherwise, the rejection of these claims should be withdrawn.

In support of the rejection of claims 18-22 and 35-40, it is contended that Marsh at column 3, lines 28-36 teaches both "a face time duration parameter" and "displaying" a selected advertisement "for the face time duration" prescribed by the associated face time parameter. The applicants respectfully disagree. The "face time" parameters relate to the time a user is "present and accounted for" when an ad is displayed. Specification, page 35, lines 20-25. The cited passage of Marsh describes an advertisement download scheduler that manages when advertisements are transmitted to a user, that transfers high priority advertisements first, and that manages the number of advertisements transmitted at any given time to reduce unnecessary user wait time. No mention is made of "a face time duration" parameter or of a step of displaying an advertisement for a face time duration. Finally, determination of face time by

measuring user activity is deemed obvious because of Marsh's logging of statistics described at column 14, line 66 through column 15, line 7. In fact this passage describes logging the duration of ad display, which may or may not correspond to "face time". Nothing in this passage describes a time period of any kind based on detection of user activity. In fact the one mention of user activity at column 15, lines 14-20 only describes logging user activity in an "event file". But there is no relationship between the entries in this event file and displaying an ad for a "face time" duration comprising a period of user activity. Accordingly, Marsh omits steps and limitations recited in claims 18-22 and 35-40. The rejection therefore does not meet the "all elements" requirement of *prima facie* obviousness. See MPEP 2142, et seq.

Thus, in view of the remarks made in this paper, it is submitted that the claims in this application define subject matter that is patentably distinct from the references of record, early notice of which is earnestly solicited.

Respectfully submitted,

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